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10/528,102	07/28/2005	Hirobumi Toyoda	ARF-085US	9111
21254 7590 07/09/2008 MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817				
			EXAMINER	
			KIM, KEVIN Y	
		ART UNIT	PAPER NUMBER	
		3714		
		NOTIFICATION DATE	DELIVERY MODE	
		07/09/2008		ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Office Action Summary

Application No.

10/528,102

Applicant(s)

TOYODA, HIROBUMI

Examiner

KEVIN Y. KIM

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 11 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. Applicant's amendment filed 2/7/2008 is addressed. Claims 6 and 8 have been amended; claims 13-16 are new.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al (US 6,824,463 B1) in view of Morsch (US 2,668,716) and Kelly et al (US 5,816,918).
4. In re claim 1, Yamaguchi discloses a gaming machine comprising:
a cabinet having a face portion on which a lottery ball can roll and a plurality of lottery holes provided on the face portion (figure 1, 10);
game result determination means for determining a game result under a condition that the lottery ball enters any one of the plurality of lottery holes of the cabinet (column 5, lines 54-57);
a withdrawing passage being provided in the cabinet, the withdrawing passage being capable of allowing lottery balls having been discharged to pass through (figure 3, 2);
lottery ball throwing means for allowing the lottery balls having been discharged

from the plurality of lottery holes through the withdrawing passage to be thrown onto the face portion of the cabinet (figure 3, 12, column 4, lines 42-45).

Yamaguchi is silent on tilt control means for tilting the cabinet, wherein the cabinet is tilted by the tilt control means such that lottery balls having been located in the withdrawing passage are directed out to the lottery ball throwing means.

Morsch teaches a means for tilting a housing (i.e. a cabinet) back and forth about the axis of a shaft (column 1, line 56 to column 2, line 15). Kelly teaches allowing a player to press a button in order to tilt a playing surface to guide a playing piece (column 7, lines 4-17).

As such, it has been shown that the tilting of a surface in order to move objects from one place to another is well known in the art. Thus, whether the tilting surface is used to transfer a ball from a withdrawing passage to a lottery ball throwing means, or whether it is used to simply move a ball across a field is irrelevant, as actual function of a tilting surface does not produce any unpredictable results.

It would have been obvious to one skilled in the art at the time the invention was made to combine the tilting means of Morsch with the cabinet of Yamaguchi in order to produce unusual and intriguing motions as to be attractive to the players or users, as well as providing another way to deliver the lottery ball to the rotating unit. Furthermore, the use of Kelly in allowing players to control a tilting surface to move a playing piece would allow those skilled in the art to modify Yamaguchi's vertical ball supply into one that moves a ball from a withdrawing passage and directed to a lottery ball throwing

means via tilting, as it is simply a matter of design choice, leading to the predictable result of the use of gravity to assist in moving objects from one place to another.

5. In re claim 2, Yamaguchi discloses:

feeding means for feeding lottery balls upward (figure 3, 2, column 4, lines 53-56);

throw-in means for throwing the lottery balls having been fed by the feeding means downward onto the face portion (figure 3, 12, column 4, lines 42-45).

Yamaguchi discloses returning balls from the withdrawing means to the feeding means (column 5, lines 42-45), but does not disclose the cabinet being tilted by the tilt control means. As discussed above regarding claim 1, Morsch teaches a tilting means. One skilled in the art would understand that there are a limited number of ways to move a ball from one location to another (e.g. gravity, tilting, conveyor belt, air pressure). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to use the tilting means of Morsch to return balls to the feeding means, as it is obvious to try, additionally yielding the predictable result of moving a ball from one place to another.

6. In re claim 3, Yamaguchi discloses the feeding means is disposed outside the cabinet, the feeding means having a function to feed the lottery balls as being visible from the outside (column 7, lines 49-55).

7. In re claim 13, Kelly teaches the use of tilting surfaces to move playing pieces (column 7, lines 4-17). Thus, by using the surface of Kelly to modify the above

references, one skilled in the art would be able to use the tilting surface to move a lottery ball from any location desired to another.

8. Claims 5, 8-11, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al (US 6,824,463 B1) in view of Morsch (US 2,668,716), Kelly et al (US 5,816,918), and Clark (US 4,548,408).

9. In re claim 5, Yamaguchi discloses a gaming machine comprising:
a cabinet having a face portion on which a lottery ball rolls, and a plurality of lottery holes being provided on the face portion (figure 1, 10);
game result determination means for determining a game result under a condition that the lottery ball enters any one of the plurality of lottery holes of the cabinet (column 5, lines 54-57);

lottery ball discharging means for discharging outside lottery balls having entered a plurality of respective lottery holes (column 6, lines 55-58);

a withdrawing passage being fixed to the cabinet, the withdrawing passage allowing the lottery balls having been discharged by the lottery ball discharging means to pass through (figure 3, 2);

lottery ball accumulating means for accumulating the lottery balls having been discharged by the lottery ball discharging means through the withdrawing passage, the lottery ball accumulating means communicating with the withdrawing passage (column 5, lines 42-45);

an open/close gate being provided between the withdrawing passage and the

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lottery ball accumulating means such that the open/close gate is opened/closed (column 6, lines 55-58);

gate control means for controlling the open/close operation of the open/close gate (figure 5, 82);

lottery ball throwing means for throwing each of the lottery balls having been accumulated by the lottery ball accumulating means onto the face portion of the cabinet (figure 3, 12, column 4, lines 42-45).

Yamaguchi is silent on tilt control means for tilting the cabinet, wherein the cabinet is tilted by the tilt control means such that the open/close gate is positioned on a lower side of the withdrawing passage, and the open/close gate is opened by the gate control means so that lottery balls located in the withdrawing passage are directed out to the lottery ball throwing means.

Please see rejection to claim 1 concerning the tilt means. Additionally, Clark teaches an open/close gate disposed on the lower side of a withdrawing passage (figure 2, 106). Above it is the withdrawing passage (figure 2, 18) where pinballs fall through. After passing through the gate, the balls collect into the accumulating means (as can be seen in figure 2, wherein balls that pass through the gate are eventually returned to the ball ejecting means as shown in figures 4-6).

It would have been obvious to one skilled in the art at the time the invention was made to combine the tilting means of Morsch and Kelly with the cabinet of Yamaguchi in order to produce unusual and intriguing motions as to be attractive to the players or users, as well as providing another way to deliver the lottery ball to the rotating unit.

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Furthermore, the use of Kelly in allowing players to control a tilting surface to move a playing piece would allow those skilled in the art to modify Yamaguchi's vertical ball supply into one that moves a ball from a withdrawing passage and directed to a lottery ball throwing means via tilting, as it is simply a matter of design choice, leading to the predictable result of the use of gravity to assist in moving objects from one place to another. Additionally, the use of a gate to control the passage of objects through wanted/unwanted areas is a well known feature in the art, and thus, one skilled in the art would be able to implement an open/close gate in a game with tilting features, as it produces the predictable result of a means of controlling the path of an object.

10. In re claim 8, please see the above rejection to claim 5, which is repeated here *mutatis mutandis*.

11. In re claim 9, please see rejections to claims 5 and 8, which are repeated here *mutatis mutandis*. However, Yamaguchi and Morsch do not disclose a swinging device for tilting the cabinet as the lottery balls roll over the face portion, wherein the cabinet is tilted such that lottery balls having been located in the withdrawing passage are directed out to the gate.

Kelly teaches allowing players to tilt a playing surface in order to guide a playing piece (column 7, lines 4-18). Thus, while it is not explicitly a swinging device, one skilled in the art would find it obvious to utilize the tilting surface of Kelly in order to provide an entertaining way to guide the balls from the withdrawing passage to the gate as discussed in Clark, as one skilled in the art has good reason to pursue the known

options within his or her technical grasp. The use of a swinging device in place of any other device leads to the predicted and anticipated result of a tilting surface.

12. In re claim 10, Yamaguchi discloses:

a slope for guiding the lottery balls from a lottery ball receiving portion to the face portion, the guided lottery balls rolling on the face portion until the guided lottery balls enter any of the plurality of lottery holes (figure 3, 123).

Yamaguchi does not disclose a screw conveyor for feeding the lottery balls upward, and that the cabinet is tilted by the swinging device such that the lottery balls located in the withdrawing passage are directed out to the screw conveyor.

The feeding method of Yamaguchi can be implemented in several ways, for example, an elevator or air pressure (column 4, lines 53-56). It would have been obvious to one skilled in the art at the time the invention was made to implement a screw conveyor in the feeder of Yamaguchi, as Yamaguchi already teaches a method of moving a ball upward, thus using a screw conveyor instead of air pressure or an elevator achieves the predictable result of moving a ball upward.

Furthermore, one skilled in the art would understand that there are a limited number of ways to move a ball from one location to another (e.g. gravity, tilting, conveyor belt, air pressure). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to use the tilting means of Morsch to return balls to the feeding means, as it is obvious to try, additionally yielding the predictable result of moving a ball from one place to another.

13. In re claim 11, Yamaguchi discloses the ball feeder being located outside the cabinet to feed the lottery balls as being visible from the outside (column 7, lines 49-55). See the discussion of claim 10 regarding the screw conveyor.

14. In re claim 14, Yamaguchi discloses the lottery ball discharging means is located between the plural lottery holes and the withdrawing passage (as can be seen in figure 2 and 3, the location which lottery balls are discharged, figure 2, 122, from the withdrawing passage 3 is located in the middle of the circle of lottery holes, figure 2, 41, and the passage, figure 3, 2).

15. In re claim 15, Clark teaches an open/close gate disposed on the lower side of a withdrawing passage (figure 2, 106). Above it is the withdrawing passage (figure 2, 18) where pinballs fall through. After passing through the gate, the balls collect into the accumulating means (as can be seen in figure 2, wherein balls that pass through the gate are eventually returned to the ball ejecting means as shown in figures 4-6).

16. In re claim 16, the positioning of gates in respect to withdrawing passages and screw conveyors is a matter of design choice, as one skilled in the art would be able to design any physical layout desired, and all lead to the predictable result of a gate as discussed in Clark preventing/allowing the passage of lottery balls from a withdrawing passage into a ball collection structure, whether it be a screw conveyor or a simple bin.

17. Claims 4 ,6, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi in view of Morsch and Kelly as applied to claim 1 above, and further in view of Tokito et al (US 5,634,639).

18. In re claim 4, Yamaguchi and Morsch have been discussed above, but are silent on detecting means for detecting a number of the lottery balls having been directed out from the withdrawing passage to the lottery ball throwing means, wherein the tilt control means that has a function to stop tilting the cabinet, under a condition that the detecting means detects that the number of the lottery balls having been directed out, as the cabinet is tilted, from the withdrawing passage to the lottery ball throwing means is a predetermined number.

Tokito teaches a method of determining the number of balls fed by a feeder by which the balls are delivered into the game (column 12, lines 54-58). Morsch has been discussed above regarding the tilt control means. It would have been obvious to one skilled in the art at the time the invention was made to combine the ball counting means of Tokito and the tilting means of Morsch with the device of Yamaguchi in order to verify to the game and to players the correct amount of balls for the current game have been delivered. Additionally, one skilled in the art would understand that in order to stop the delivery of balls that are being delivered by the tilting means as discussed in claim 2, the device may simply stop being tilted.

19. In re claim 6, Yamaguchi and Morsch have been discussed above, but are silent on detecting means for detecting a number of the lottery balls passing through the open/close gate, wherein the gate control means that has a function to close the open/close gate if a number of the lottery balls having passed through the open/close gate reaches a predetermined number.

Tokito teaches a method of determining the number of balls fed by a feeder by

which the balls are delivered into the game (column 12, lines 54-58). It would have been obvious to one skilled in the art at the time the invention was made to implement the counting method of Tokito with the open/close gate of Yamaguchi in order to verify to the game and players that the correct amount of balls for the current game have been delivered, ensuring that gameplay is not flawed.

20. In re claim 12, Yamaguchi and Morsch have been discussed above, but do not disclose a sensor for detecting a number of the lottery balls having been directed out from the withdrawing passage to the gate, wherein the swinging device has a function to stop tilting the cabinet, under a condition that the sensor detects that a predetermined number of lottery balls have been directed out, as the cabinet is tilted, from the withdrawing passage to the gate is a predetermined number.

Tokito teaches a method of determining the number of balls fed by a feeder by which the balls are delivered into the game (column 12, lines 54-58). Morsch has been discussed above regarding the tilt control (i.e. swing control) means. It would have been obvious to one skilled in the art at the time the invention was made to combine the ball counting means of Tokito and the tilting means of Morsch with the device of Yamaguchi in order to verify to the game and to players the correct amount of balls for the current game have been delivered. Additionally, one skilled in the art would understand that in order to stop the delivery of balls that are being delivered by the tilting means as discussed in claim 2, the device may simply stop being tilted.

21. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi in view of Morsch, Kelly, and Tokito as applied to claim 4 above, and further in view of Isetani et al (US Des. 393,664).
22. In re claim 7, the invention has been disclosed by much of the above, but does not disclose the cabinet being designed in a ship-shape. Isetani teaches a game machine with the shape of a watercraft (a ship). It would have been obvious to one skilled in the art at the time the invention was made to design a gaming cabinet as a watercraft, as it is a matter of design choice which yields predictable results.

Response to Arguments

23. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN Y. KIM whose telephone number is (571)270-3215. The examiner can normally be reached on Monday-Thursday, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. Y. K./

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Examiner, Art Unit 3714

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3714